Practitioner's Docket No. MPI00-471P1RM (previously 10147-61U1) ***PATENT***

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Glucksmann, Maria A., et al		
Application No.:	09/970,287	Group No.:	1635
Filed:	October 03, 2001	Examiner:	Karen A. Lacourciere
For:	22437, A NOVEL HUMAN SULFATASE AND USES THEREFOR		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

Responsive to the Restriction Requirement dated June 24, 2003 (Paper No. 8), the claims of Group IX (claims 28-30), drawn to methods of assessing a test compound for the ability to modulate tumor establishment, growth or metastasis, epithelial or endothelial cell proliferation, neuronal cell growth, wound healing or cerebral injury healing by measuring the binding of the compound to a 22437 protein of SEQ ID NO:2, are elected for prosecution with traverse.

CERTIFICATION UNDER 37 C.F.R. SECTIONS 1.8(a) and 1.10*

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Applicants hereby reserve the right to traverse the above restriction with respect to non-elected Groups I-VIII in this or subsequent applications.

GROUNDS FOR TRAVERSAL

The Examiner states that the application contains multiple independent and patentably distinct inventions (inventions of Group I-IX) and has required restriction under 35 U.S.C. § 121. According to the Examiner, the application contains claims directed to the following inventions:

Groups I-II (Claims 1-7 and 13-18), drawn to methods of inhibiting the ability of a cell to degrade an extracellular matrix by inhibiting expression of 22437;

Group III (Claims 1 and 8-18), drawn to a method of inhibiting the ability of a cell to degrade an extracellular matrix by inhibiting 22437 catalytic activities without affecting gene expression;

Group IV (Claims 19-25), drawn to a method of assessing a test compound for the ability to modulate tumor establishment, growth or metastasis, epithelial or endothelial cell proliferation, neuronal cell growth, wound healing or cerebral injury healing by measuring the activity of a 22437 protein;

Group V (Claim 26), drawn to a method of making a pharmaceutical composition;

Group VI (Claim 27), drawn to a method of modulating tumor establishment, growth or metastasis, epithelial or endothelial cell proliferation, neuronal cell growth, wound healing or cerebral injury healing in a human; and

Groups VII-IX (Claims 28-30), drawn to a method of assessing a test compound for the ability to modulate tumor establishment, growth or metastasis, epithelial or endothelial cell proliferation, neuronal cell growth, wound healing or cerebral injury healing by measuring the binding of the compound to a 22437 protein.

The Examiner has required election of a single invention on the basis that Groups I-IX are different methods that require different modes of operation. Applicants respectfully request modification of the Restriction Requirement, and propose that Groups I-II and Groups VII-IX be combined. The Examiner has separated the inventions of Groups I and II and those of Groups

VII, VIII and IX according to the sequence of either SEQ ID NO:1, SEQ ID NO:2 or SEQ ID NO:3.

It is of the Examiner's opinion that "A search of more than one (1) of the target sequences claimed in Groups I and II (and likewise Groups VII and VIII) presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of these sequences." Applicants note, however, that SEQ ID NO:3 corresponds to the open reading frame of SEQ ID NO:1 and that both SEQ ID NO:1 and SEQ ID NO:3 encode the protein sequence of SEQ ID NO:2. Therefore, combining Groups I-II and VII-IX as proposed herein, would not place any additional burden on the Examiner, since a search of SEQ ID NO:1 necessarily encompasses a search of SEQ ID NO:3, and since both encode the protein sequence of SEQ ID NO:2. In short, the protein sequence of SEQ ID NO:2 is the same as the protein encoded by SEQ ID NO:1 and the protein encoded by SEQ ID NO:3.

Furthermore, the proposed regrouping comports with the United States Patent Office Procedure as stated in the Manual of Patent Examination Procedure:

> If the search and examination of an entire application can be made without serious burden, the Examiner must examiner it on the merits, even though it includes claims to independent or distinct inventions (M.P.E.P § 803 at 800-3 (8th ed., Aug 2001)).

Therefore, Groups I-II and Groups VII-IX should be combined into two distinct groups, since no additional burden would be placed on the Examiner by the concurrent search and examination of any one of the new combined groups. Applicants' suggestion to modify the Restriction Requirement by combining the claims of Groups I-II and Groups VII-IX, should not be construed as an indication that Applicants believe that the patentably distinct claims within the joined groups stand or fall together.

If the Examiner agrees to the proposed modification, Applicants elect the combined Groups VII-IX. Claims readable thereon are claims 28-30, drawn to SDEQ ID NOs:1-3.

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This paper is being filed timely as a request for a one month extension of time is filed concurrently herewith. No additional extensions of time are required. In the event any additional extensions of time are necessary, the undersigned hereby authorizes the requisite fees to be charged to Deposit Account No. 501668.

Entry of the remarks made herein is respectfully requested.

Respectfully submitted,

August 25, 2003

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By _____

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